UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,181	02/18/2004	Mark D. Fidock	PC10315B	2122

28523 7590 01/19/2006

PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

EXAMINER	
SAIDHA, TEKCHAND	
ART UNIT	**PAPER NUMBER**
1652	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/781,181	FIDOCK, MARK D.	
	Examiner	Art Unit	
	Tekchand Saidha	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2004*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-12* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1 (in-part), drawn to a phosphodiesterase 7 (PDE 7) of SEQ ID NO: 1, classified in class 435, subclass 196.

II. Claim 1 (in-part), drawn to a phosphodiesterase 7 (PDE 7) of SEQ ID NO: 3, classified in class 435, subclass 196.

III. Claim 1 (in-part), drawn to a phosphodiesterase 7 (PDE 7) of SEQ ID NO: 5, classified in class 435, subclass 196.

IV. Claims 2-5 & 12 (all in-part), drawn to a polynucleotide of SEQ ID NO: 2, encodes PDE 7, vector and host cell, classified in class 435, subclass 252.3.

V. Claims 2-5 & 12 (all in-part), drawn to a polynucleotide of SEQ ID NO: 4, encodes PDE 7, vector and host cell, classified in class 435, subclass 252.3.

VI. Claims 2-5 & 12 (all in-part), drawn to a polynucleotide of SEQ ID NO: 6, encodes PDE 7, vector and host cell, classified in class 435, subclass 252.3.

VII. Claims 6-7 (all in-part), drawn to an assay method for identifying an agent that effect PDE 7 activity of SEQ ID NO: 1, classified in class 435, subclass 15.

VIII. Claims 6-7 (all in-part), drawn to an assay method for identifying an agent that effect PDE 7 activity of SEQ ID NO: 3, classified in class 435, subclass 15.

IX. Claims 6-7 (all in-part), drawn to an assay method for identifying an agent that effect PDE 7 activity of SEQ ID NO: 5, classified in class 435, subclass 15.

X. Claim 8 (in-part), use of gene encoding PDE 7 isozyme of SEQ ID NO: 1, to screen for agent modulating the activity of PDE isozyme, classified in class 435, subclass 69.2.

XI. Claim 8 (in-part), use of gene encoding PDE 7 isozyme of SEQ ID NO: 3, to screen for agent modulating the activity of PDE isozyme, classified in class 435, subclass 69.2.

XII. Claim 8 (in-part), use of gene encoding PDE 7 isozyme of SEQ ID NO: 5, to screen for agent modulating the activity of PDE isozyme, classified in class 435, subclass 69.2.

XIII. Claims 9-11 (all in-part), antibody against PDE 7 isozyme of SEQ ID NO: 1, and hybridoma producing the antibody, classified in class 530, subclass 387.1.

XIV. Claims 9-11 (all in-part), antibody against PDE 7 isozyme of SEQ ID NO: 3, and hybridoma producing the antibody, classified in class 530, subclass 387.1.

XV. Claims 9-11 (all in-part), antibody against PDE 7 isozyme of SEQ ID NO: 5, and hybridoma producing the antibody, classified in class 530, subclass 387.1.

2. The inventions are distinct, each from the other because of the following reasons:

3. Each of the PDE of SEQ ID Nos. 1, 3 or 5 (Groups I-III), as well as each of polynucleotides of SEQ ID Nos. 2, 4 or 6 (Groups IV-VI), are structurally distinct from each other. Each of the polynucleotides encodes a distinct amino acid

sequence, wherein the structurally distinct PDE also have varying enzyme activity levels.

4. Each of the enzymes of Group I-III are related to each of the polynucleotides of Group IV-VI by virtue of the fact that the polynucleotides encode the enzymes. The polynucleotides has utility for the recombinant production of the enzyme in a host cell. Although the polynucleotides and the enzyme are related, they are distinct inventions because the enzyme product can be made by other and materially distinct processes, such as purification from a natural source. Furthermore, polynucleotides can be used for processes other than the production of enzyme, such as nucleic acid hybridization assays. Therefore, Groups I-III and IV-VI are patentably distinct.

5. Each of the Inventions of groups I-III and each of the groups VII-IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as in the preparation of antibodies, instead of a method for identifying an agent that effects PDE activity.

6. Each of the product of Inventions I-III are not used in the use of gene or method of Invention for screening agents and/or expression products of each of the groups X-XII. Therefore, Inventions of each of groups I-III, and each of groups X-XII are patentably distinct.

7. Each of the proteins of Inventions I-III are related to each of the antibodies of Inventions XIII-XV by virtue of being the cognate antigen, necessary for the production of antibodies. Although the protein and antibody

are related due to the necessary stearic complementarity of the two, they are distinct Inventions because the protein can be used in another and materially different process from the use for the production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein (if the protein is itself a receptor), or in assays for the identification of agonists or antagonists of the receptor protein.

8. Each of the nucleic acids of Inventions IV-VI and the antibody of Invention XIII-X are related by virtue of the protein that is encoded by the nucleic acid and necessary for the production of the antibody. However, the nucleic acid itself is not necessary for antibody production and both are wholly different compounds having different compositions and functions. Therefore, these Inventions are distinct.

9. Because these inventions are distinct for the reasons given above and the search required for each of the groups is distinct, restriction for examination purposes as indicated is proper. For example, each of the sequences require a separate search, apart from searching the various classes and/or subclasses.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Rejoinder - The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tekchand Saidha
Primary Examiner, Art Unit 1652
Recombinant Enzymes, E03A61 Remsen Bld.
400 Dulany Street, Alexandria, VA
Telephone: (571) 272-0940
January 10, 2006